

Attorney Docket No. P67074US0
Application No. 09/931,811

REMARKS/ARGUMENTS

Claims 37-42, presented hereby, are pending.

Claims 1-36 are canceled hereby, without prejudice or disclaimer.

Claims 37-72 correspond to claims 1-36, respectively, revised to more clearly define the subject invention. In particular, the changes are made to address the rejections of record under section 112, second paragraph, and section 101, as explained below.

Claims 1-36 were rejected under 35 USC 112, second paragraph, for allegedly being indefinite. Reconsideration is requested in view of the changes made pursuant to the instant amendment.

Claim 1 is allegedly indefinite for reciting in the preamble a "electrochromatography (CEC) device," without expressly reciting in the claim "any source of electric potential" (Office Action, page 2). The allegation fails to support the rejection because a patent applicant is entitled to be his own lexicographer and claim terms need not be "conventional." *In re Castaing*, 166 USPQ 550 (CCPA 1970).

Notwithstanding the lack of support for the rejection of claim 1 under section 112, second paragraph, the claim is amended hereby, as claim 37, to address the issue raised, in order to advanced prosecution. Accordingly, the "electrochromatography device" recited in the rejected claim is changed by the instant amendment to read a "device for capillary electrochromatography."

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Claim 17 was found indefinite for allegedly failing to recite any method steps. By the instant amendment, claim 17 is revised, as present claim 53, the method step "applying a sample to a support material."

In view of the changes effected, hereby, in amending claims 1 and 17 (as present claims 37 and 53, respectively), the rejection under 35 USC 112, second paragraph, is overcome. Accordingly, withdrawal of the rejection appears to be in order.

Claim 17 was rejected under 35 USC 101 as allegedly being non-statutory; i.e., according to statement of rejection, "because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process" (Office Action, page 2). Reconsideration is requested.

As explained, above, claim 17 is amended hereby, as present claim 53, to recite the active method step "applying a sample to a support material." Since the replacement claim sets forth *a step involved in the method*, the rejection is overcome. Accordingly, withdrawal of the rejection appears to be in order.

Claims 1-36 were rejected under 35 USC 103(a) as being allegedly unpatentable over WO 00/50886 ("WO"). Reconsideration is requested.

As implicitly acknowledged in the statement of rejection, obtaining domestic priority to international application PCT/EP00/01393 – the parent of the subject continuation-in-part application – would overcome the rejection. That is, WO has an effective date as prior art (against the subject application) of 31 August 2000 (its publication date). Since parent application

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PCT/EP00/01393 was filed 21 February 2000, the parent application *antedates* the effective date of WO as prior art. Accordingly, obtaining priority to the parent application renders WO inapplicable as prior art against the present claims.

In order to confirm domestic priority to the parent application, applicant submits, herewith, an English language translation of the parent application as originally filed on 21 February 2000.

Accordingly, since WO is unavailable as prior art against the present claims – the effective date of WO as prior art being antedated by the domestic priority date of the subject application – the rejection under 35 USC 103(a) based on WO is overcome. Withdrawal of the rejection appears to be in order.

Although not required for award of priority under the circumstances, submitted herewith are English translations of the two §119(a) (foreign) priority documents, i.e., translation of DE 199 07 296.5, filed 22 February 1999, and translation of DE 10 004 673.8, filed 3 February 2000. This confirms the priority claims under §119(a), set forth in the inventorship declaration of record.

Request for Examiner's Initialed Form PTO 1449

On November 1, 2001, an Information Disclosure Statement, including completed form PTO 1449 and copies of the cited references, was filed in the PTO. To date, the submitted PTO form 1449, initialed by the Examiner to show consideration of the references cited thereon, was neither attached to the Office Action nor included with any paper previously issued by the PTO.

Accordingly, it is requested that the PTO return the submitted form PTO 1449, initialed by the Examiner to show that the references cited, thereon, were considered by the Examiner during

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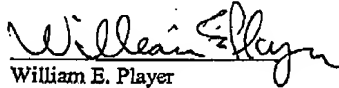
prosecution of the subject application. For the Examiner's convenience, attached hereto are copies of the IDS as originally filed (less references) and the corresponding PTO receipt card - date stamped "NOV 01 2001" by the PTO.

Favorable action is requested.

Respectfully submitted,

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